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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,802	09/29/2003	Ok-Nam Cho	4898-107 US	2988

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EXAMINER	
DOAN, ROBYN KIEU	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/673,802	CHO, OK-NAM	
	Examiner	Art Unit	
	Robyn Doan	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention..

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 5, line 13 recited limitations "such that they are engaged in three-steps" which fail to show one of ordinary skill in the art how to make the invention. Therefore, such limitations will be treated as a method step of assembling the device for the examination purpose.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is not clearly understood what being referred to as "each other" in lines 10-11.

These claims appear to be a literal translation of foreign filed claims and specification and as such contain errors of form and/or grammar, i.e., claim 1, line 13 "said heating plate are completely projected", line 4 "hair to be held therebetween is cared", "is made of cushion materials" in lines 9-10 of claim 5. Applicant is required to check the entire disclosure and place in proper U.S. form. Also, Applicant does not clearly described the term "adiabatic functions" of the connection member in the disclosure, therefore, the connection member will be treated as an insulating member for the examination purpose.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Carter (U.S. Pat. # 4,242,567).

With regard to claim 1, Carter discloses a hair iron (figs. 1-2) comprising a hair of heating portions (22, 24) each heating portion forming at an inner surface of a pair of body portions (14, 16) wherein the hair being held between the heating portions; each of the heating portion (col. 2, lines 53-57) having a heating plate (24) that a current being applied and a temperature being maintained uniformly (col. 2, lines 60-68), a connection member defining as an insulating member (34, 46) being engaged with the heating plate, a body (16) which the connection member being engaged (col. 3, lines 42-44); wherein the heating plate , the connection member and the body being assembled such that the heating plate being completely projected to the outside of the body, see fig. 1. With regard to the step "such that they are engaged in three-steps", all the actual claimed structures have been shown, the method of making is given no patentable weight in an article claim.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Okumoto et al.

With regard to claims 1-2, Okumoto et al discloses a hair iron (figs. 1, 2, 6 and 10b) comprising a hair of heating portions (8, 18) each heating portion forming at an inner surface of a pair of body portions (6, 17) wherein the hair being held between the heating portions (fig. 6); each of the heating portion comprising a heating plate (8, 18), a connection member (8a, 18a, figs. 3 and 10b) being engaged with the heating plate, a body (6, 17) which the connection member being engaged; wherein the heating plate , the connection member and the body being assembled such that the heating plate being completely projected to the outside of the body, see figs. 10a-b. Okumoto et al also discloses a Teflon coating being coated to the surfaces of the heating plate (8, 18) for improving heat resistant and since the connection member (8a, 18a) being a part of the heating plate, the connection member would inherently be heat resistant. Okumoto et al further discloses the heating portion such that a minute space (30) being formed among the heating plate, the connection member and the body and the transfer of the heat generated from the heating to the body can be minimized (col. 7, lines 44-48). With regard to the step "such that they are engaged in three-steps", all the actual claimed structures have been shown, the method of making is given no patentable weight in an article claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumoto et al in view of Browning (U.S. Pat. # 1,993,956).

With regard to claims 3-4, Okumoto et al discloses the claimed invention as discussed above in claim 1 except for the connection member being formed with protrusion to be engaged with the heating plate and the body and when engaged with each other the heating plate, the connection member and the body being formed with a gap and being contacted in a spot. Browning discloses an electric sadiron (figs. 4 and 9) comprising a heating plate (41), an insulating member (66) with protrusions (67) and a body (12). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the insulating member with protrusions as taught by Browning between the heating plate and the body of Okumoto et al for the purpose of providing an air insulating therebetween because Browning suggests a solution to the problem of creating an insulating space.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okumoto et al in view of Horner (U.S. Pat. # 3,060,300).

With regard to claim 5, Okumoto et al discloses the claimed invention as discussed above in claim 1 except for a spacing member of cushion material being disposed between the connection member and the body. Horner discloses a heating unit (figs. 4-5) comprising a heating panel (12), a spacing member (36) being made of cushion material (col. 2, lines 30-37) and an insulating member (16); the spacing member being provided to assure an insulating air space between the panel and the insulating member. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the cushion spacing member as taught by Horner above the connecting member of Okumoto et al for the purpose of providing a better way of minimizing the generated heat from the heating plate to the body because Horner suggests a solution to the problem of creating an insulating space.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,653,599. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1, 3-4 of the application and claim 1of the patent lies in the fact that the patent claim includes many more elements and thus is more specific. Thus the invention of claims 1, 3-4 is in effect a "species" of the "generic" invention of claim 1. It has been held that the generic invention is "anticipated" by the "species". See In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1, 3-4 are anticipated by claim 1 of the patent, it is not patentably distinct from claim 1.

It is clear that all elements of claims 1, 3-4 are to be found in claim 1 of the patent. Clearly, the term "connection member having adiabatic functions" of claim 1 is synonymous with the term "insulator" as used in line 10 of claim 1 of the patent. Also, the term "body" of claim 1 is synonymous with the term "arm" as used in line 13 of the claim of the patent.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kanehira et al is cited to show a surgery device having two bodies each body including a heating plate, a connecting member and a body. Henson, and Nakamura are cited to show the state of the art with respect to a hair iron.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robyn Doan
Examiner
Art Unit 3732